

REMARKS/ARGUMENTS

Claims 1, 2 and 6-16 are pending. By this Amendment, claims 3 and 5 are cancelled and claims 1, 7 and 8 are amended. Support for the amendments to claims 1, 7 and 8 can be found, for example, in the instant specification at page 4, lines 1 to 2, page 9, lines 3 to 13, page 12, lines 12 to 16, and page 19, lines 26 to 29 and in original claims 1, 3, 5, 7 and 8. No new matter is added. In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

Rejection Under 35 U.S.C. §112, First Paragraph

The Office Action rejects claims 1-3 and 5-16 under the written description requirement of 35 U.S.C. §112, first paragraph. Claims 3 and 5 are cancelled, rendering the rejection moot as to those claims. As to the remaining claims, Applicant respectfully traverses the rejection.

The Office Action asserts that the recitation of "from more to 2 to 4 mass%" of polyorganosiloxane in the aromatic polycarbonate-polyorganosiloxane copolymer of component (A), is not supported by the specification as filed. While Applicant does not necessarily agree with this assertion, claims 1, 7 and 8 have been amended to recite "the content of a polyorganosiloxane in the aromatic polycarbonate-polyorganosiloxane copolymer of component (A) is from 0.1 to 4 mass %," which the Office Action indicates is supported by the original specification. Claims 2, 6 and 9-16 are rejected solely for their dependency from claim 1.

For the foregoing reasons, claims 1, 2 and 6-16 are fully supported by the specification as filed. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection Under 35 U.S.C. §103

The Office Action rejects claims 1-3 and 5-16 under 35 U.S.C. §103(a) over U.S. Patent No. 6,727,312 to Nodera ("Nodera 312") in view of U.S. Patent No. 6,001,929 to Nodera et al. ("Nodera 929") and U.S. Patent No. 6,664,313 to Hirai et al. ("Hirai"). Claims 3 and 5 are cancelled, rendering the rejection moot as to those claims. As to the remaining claims, Applicant respectfully traverses the rejection.

Claim 1 is directed to "[a] thermoplastic resin composition comprising: (A) 0.5 to 99.9 mass % of an aromatic polycarbonate-polyorganosiloxane copolymer ... 0 to 99.5 mass % of an aromatic polycarbonate ... 0.1 to 5 mass % of fine silica having an average particle diameter of 50 nm or less, wherein said fine silica is dispersed in a solvent; and (D) 0 to 2 mass % of a polytetrafluoroethylene" (emphasis added). Claim 7 is directed to "[a] thermoplastic resin produced by a process comprising: compounding ... 0.1 to 5 mass % of a fine silica having an average particle diameter of 50 nm or less, wherein said fine silica is dispersed in a solvent ..." (emphasis added). Claim 8 is directed to "[a] method of producing a thermoplastic resin composition, said method comprising: compounding ... 0.1 to 5 mass % of a fine silica having an average particle diameter of 50 nm or less, wherein said fine silica is dispersed in a solvent ..." (emphasis added). Nodera 312, Nodera 929 and Hirai do not disclose or suggest such compositions, resins or methods.

At the outset, it is undisputed that none of Nodera 312, Nodera 929 and Hirai explicitly discloses a composition, resin, or method employing a silica having an average particle diameter of 50 nm or less that is dispersed in a solvent. The Office Action relies on Nodera 312 for its disclosure of a resin composition/method employing an "inorganic filler" in an amount of from 1 to 50 parts by weight relative to 100 parts by weight of resin. *See* Office Action, page 4. Nodera 312 does not disclose or suggest employing silica at all, much less silica having a particular average particle diameter and being dispersed in a solvent, as

recited in claims 1, 7 and 8. *See, e.g.*, column 8, lines 14 to 20. Moreover, Nodera 312 suggests that the disclosed fillers should have a particle size of from 100 to 5,000 nm (0.1 to 50  $\mu\text{m}$ ), a size much larger than the "50 nm or less" recited in claims 1, 7 and 8. *See* column 8, lines 20 to 23. Rather than suggesting the particular silica recited in claims 1, 7 and 8, by virtue of its teachings relating to particle size, Nodera 312 appears to teach away from employing such a silica. Nodera 312 fails to disclose or suggest employing a silica having an average particle diameter of 50 nm or less and being dispersed in a solvent.

Nodera 929 fails to remedy the deficiencies of Nodera 312. The Office Action relies on Nodera 929, as with Nodera 312, for its disclosure of a resin composition/method employing an inorganic filler such as silica. *See* Office Action, page 5. The Office Action correctly points out that Nodera 929 discloses that silica could be employed in the disclosed resin compositions/methods. *See* column 5, line 65 to column 6, line 4. However, Nodera 929 merely lists silica as one of numerous inorganic fillers that could be employed in the disclosed resin compositions/methods. *See id.* Moreover, Nodera 929 provides no guidance whatsoever regarding the form in which any of the disclosed inorganic fillers should be employed in the disclosed resin compositions/methods. As indicated above, claims 1, 7 and 8 require that the recited silica have an average particle diameter of 50 nm or less and be dispersed in a solvent. Nodera 929 does not disclose or suggest any particular particles size for the disclosed inorganic fillers (or silica in particular). Nodera 929 also does not disclose or suggest that the disclosed inorganic fillers (or silica in particular) be dispersed in a solvent. Accordingly, Nodera 929 fails to disclose or suggest employing a silica having an average particle diameter of 50 nm or less and being dispersed in a solvent.

Hirai, likewise, fails to remedy the deficiencies of Nodera 312 and Nodera 929. The Office Action relies on Hirai for its disclosure of a resin composition/method employing silica. *See* Office Action, pages 5 to 6. The Office Action correctly points out that Hirai

discloses that silica could be employed in the disclosed resin compositions/methods. *See* column 4, line 65 to column 5, line 36. However, Hirai provides no guidance regarding the average particle size of silica that should be used, and provides no indication that the silica should be provided dispersed in a solvent, as required by claims 1, 7 and 8. The Office Action asserts that it is "not clear" that the silica particles of Hirai would or would not have an average particle diameter outside of the ranges recited in claims 1, 7 and 8. *See* Office Action, pages 6 to 7. It is "not clear" that the silica particles of Hirai would have the recited average particle diameters, because Hirai provides no teaching or suggestion that a particular average particle diameter should be selected. The mere possibility that the silica particles of Hirai could fall within the average particle diameter ranges recited in claims 1, 7 and 8 is not sufficient to support a rejection of those claims. *See, e.g.,* MPEP §2112.IV (citing *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993)) ("The fact that certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of the result or characteristic"). Accordingly, Hirai fails to disclose or suggest employing a silica having an average particle diameter of 50 nm or less and being dispersed in a solvent.

As neither Nodera 312, Nodera 929 nor Hirai discloses or suggests employing a silica having an average particle diameter of 50 nm or less and being dispersed in a solvent, the combination of references fails to disclose or suggest each and every feature of claims 1, 7 and 8.

Moreover, the non-obviousness of employing a silica having an average particle diameter of 50 nm or less and being dispersed in a solvent is further evidenced in the present specification. For example, the present specification demonstrates that employing silica dispersed in a solvent provides superior results by improving the dispersibility of the silica in a resin composition and improving the impact strength of articles formed from the resulting composition. *See, e.g.,* page 22, lines 9 to 14. In addition, the cited references fail to

appreciate the advantages of employing silica in the amounts recited in claims 1, 7 and 8. While the cited references may disclose broad ranges of amounts of inorganic fillers, the references fail to recognize that by employing the silica recited in claims 1, 7 and 8 in amounts ranging from 0.1 to 5 mass % particular difficulties can be avoided. As described in the present specification, employing fine silica in amounts of less than 0.1 mass % adversely affects drop-preventing effect, while employing amounts of fine silica in excess of 5 mass % adversely affects flame retardancy, impact resistance and appearance. *See, e.g.*, page 12, lines 6 to 11. Nodera 312, Nodera 929 nor Hirai do not disclose or suggest employing a silica as recited in claims 1, 7 and 8, and do not recognize the advantages stemming therefrom.

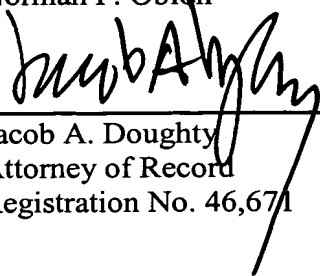
As explained, claims 1, 7 and 8 would not have been rendered obvious by Nodera 312, Nodera 929 and Hirai. Claims 2, 6 and 9-16 depend from claim 1 and, thus, also would not have been rendered obvious by the cited references. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

#### Conclusion

For the foregoing reasons, Applicant submits that claims 1, 2 and 6-16 are in condition for allowance. Prompt reconsideration and allowance are respectfully requested.

Respectfully submitted,

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